

REMARKS

Applicant is in receipt of the Office Action mailed October 20, 2006. Reconsideration of the present case is earnestly requested in light of the following remarks.

Claims 1-3 and 5-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kerrigan (U.S. Patent No. 5,404,488) in view of Roeber (U.S. Patent No. 5,682,328) and in further view of Victor (U.S. Patent No. 6,651,030). Applicant respectfully traverses these rejections.

Applicant first notes that the Victor patent was filed on June 21, 2002 but claims priority to a provisional application filed on June 22, 2001. The present application was filed on August 2, 2001, which is approximately 6 weeks after the possible effective date of the Victor reference. Applicant notes that the claimed invention was established prior to the effective date of the Victor reference. However, Applicant has not filed an affidavit or declaration of prior invention under 37 CFR 1.131 at this time. Applicant believes it is not necessary to do so because the cited references do not form a *prime facie* case of obviousness.

Independent claim 11 recites in pertinent part, “the first computer system sending a single message to the second computer system, wherein the single message comprises the first plurality of real time measurement data values”. These limitations are not taught by the cited references, taken either singly or in combination. With respect to these limitations, the Examiner cites Kerrigan, Col. 1, lines 62-67, which teach that, “The sending means sends only those cached data values which are determined to be different.” However, Kerrigan does not teach that the cached data values which are determined to be different are sent in a single message, as recited in claim 11. Furthermore, the combination of cited references does not teach sending a single message comprising a plurality of real time measurement data values from a first computer system to a second computer system. Applicant thus respectfully submits that claim 11 is patentably distinct over the cited references for at least these reasons.

Applicant also notes that the Roeber reference is not analogous art with respect to the subject matter recited in the present claims. Applicant respectfully reminds the Examiner that, “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The subject matter recited in claims 1-3 and 5-16 relates to the analysis of data in automated test and measurement systems, e.g., where measurement devices are used to acquire real time measurement data from physical systems. In contrast, Roeber teaches that, “The present invention relates to software and software system development tools, and more particularly to an improvement for tools used to collect and display information about timing inter-relationships and behavior of a program.” See the Field of the Invention, Col. 1, lines 5-9. More particularly, Roeber teaches that, “The present invention provides a method and apparatus for event logging in a flexible, extensible and minimally intrusive implementation for systems composed of one or more target processors that may be bus masters or slave-only.” (Col. 3, lines 19-24). This is clearly not the same field as Applicant's endeavor, and the problem of logging events for a system composed of one or more target processors is not particularly pertinent to the problem with which the inventors in the present application are concerned. Applicant thus respectfully submits that Roeber is not analogous art with respect to the subject matter recited in claims 1-3 and 5-16.

Furthermore, as the Examiner is certainly aware, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)” as stated in the MPEP §2142 (*emphasis added*).

As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. Furthermore, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular. . .Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant respectfully submits that there is no clear and particular teaching or suggestion in the prior art for combining Roeber with Kerrigan. The Examiner states that, “It would be obvious to one of ordinary skill in the art at the time the invention was made to use Roeber’s teaching on Kerrigan’s system to allow applications on remote systems to gain access to the real-time information measurement streams to perform remote analytical processing on the data in the database.” However, the Examiner has provided no indication of any clear and particular teaching or suggestion in the prior art for making this modification, as required to form a case of *prima facie* obviousness. Applicant respectfully submits that there is no such clear and particular teaching or suggestion, and that the Examiner’s obviousness claim is defective as hindsight analysis.

Applicant thus respectfully submits that independent claim 11 is patentably distinct over the cited references for at least the reasons set forth above. Inasmuch as independent claim 3 recites limitations similar to those discussed above, Applicant respectfully submits that claim 3 is also patentably distinct over the cited references.

Since the independent claims have been shown to be patentably distinct over the cited references, Applicant submits that the dependent claims are also patentably distinct, for at least this reason. Applicant also respectfully submits that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the

independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-57700/JCH.

Respectfully submitted,

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